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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/584,226

06/23/2006

Walter Blum

RO4265US (#90568)

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1794

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/584,226	<b>Applicant(s)</b> BLUM ET AL.	
	<b>Examiner</b> Patricia L. Nordmeyer	<b>Art Unit</b> 1794	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/23/06</u> .   | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1 – 11 and 14 - 16 in the reply filed on March 3, 2008 is acknowledged. The traversal is on the ground(s) that the purposes and composition of the adhesive tapes of DE 100 63 018 A1 and the present invention are quite different. This is not found persuasive because claim 1 has a large variety of compositions of the adhesive, which DE 100 63 018 A1 reads upon as shown below. With regard to the purposes of the two inventions being quite different, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1 – 11 and 14 – 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “comprising at least one flexible, self-adhesive core or at least one flexible, self-adhesive carrier layer provided with an envelope or two-sided coating” in claim 1 is unclear, which renders the claim vague and indefinite. It is unclear from the claim language and specification how the tape is constructed. The tape seems to either be a double sided tape, if that is what is meant by envelope coating, or a tape that has a carrier layer with two adhesive layers in contact with each other and coated on a single side of the carrier layer.

The phrase “comprising a second adhesive system” in claim 1 is unclear, which renders the claim vague and indefinite. It is unclear from the claim language and specification how there is a second adhesive system when it is unclear if there is a first adhesive system.

The phrase “wherein the pressure sensitive adhesive tape is based on a pure dispersion acrylate” in claim 3, which renders the claim vague and indefinite. It is unclear from the claim language and specification what part of the tape is made with a pure dispersion acrylate.

4. Claim 3 recites the limitation "pressure-sensitive adhesive tape" in claim 1. There is insufficient antecedent basis for this limitation in the claim. Claim 1 is silent with regard to pressure sensitive adhesive tape.

Claims 2, 4 – 11 and 14 – 16 are rejected under 35 U.S.C. 112 2<sup>nd</sup> paragraph due to their dependency on the above rejected claims.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 4, 6 – 8, 14, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by DE 100 63 018 A1 (machine translation).

DE '018 discloses a self-adhesive, flexible sealing tape (Claim 1) comprising at least one flexible, self-adhesive core or at least one flexible, self-adhesive carrier layer (Claim 7) provided with an envelope or two-sided coating comprising a second adhesive system (Claim 7), wherein the envelope/coating of comprises an expanded pressure-sensitive adhesive tape (Claims 5 and 8), and that the material for the core/the carrier layer is selected from the group comprising thermoplastic rubbers on the basis of styrene-isoprene-styrene block copolymers, styrene-butadiene-styrene block copolymers, copolymers of vinyl acetate and acrylates (Page 2, lines 3 – 24) as in claim 1. With regard to claim 2, the material for the core/the carrier layer has a glass transition temperature (T<sub>g</sub>) of below 0 °C is inherent since the materials of the carrier layer are the desired materials. As in claim 3, the pressure-sensitive adhesive tape is based on a pure dispersion acrylate (Page 2, 2<sup>nd</sup> to last paragraph). Regarding claim 4, the pure dispersion acrylate is based on plasticizing monomers selected from the group consisting of 2-ethylhexyl acrylate, 1-butyl acrylate and n-butyl acrylate (Page 2, lines 41 – 50). With regard to claim 6, the thickness of the core/the carrier layer is between 0.1 mm and 8 mm (Claim 7). As in claims 7

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and 15, the width of the core/the carrier layer is between 1 mm and 10 mm (Example 2).

Regarding claims 8 and 16, the thickness of the envelope/coating is between 0.2 and 1.5 mm (Claim 7). As in claim 14, the tape is used for adhesively bonding vapour barrier films or vapour retarder films, by adhesively bonding said films to walls (Claim 11).

With regard to the limitations of “which have been cross-linked by a process selected from the group consisting of thermally and UV irradiation”, the limitation defines the product by how the product was made. Thus, claim 1 is a product-by-process claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure of a flat carrier sheet. The reference suggests such a product.

7. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Peltier (USPN 3,297,846).

Peltier discloses a self-adhesive, flexible sealing tape (Figure 2) comprising at least one flexible, self-adhesive core or at least one flexible, self-adhesive carrier layer (Figure 2, #12) provided with an envelope or two-sided coating comprising a second adhesive system (Figure 2, #18 and 14), wherein the envelope/coating of comprises an expanded pressure-sensitive adhesive tape (Column 3, lines 61 – 70), and that the material for the core/the carrier layer is selected from the group comprising thermoplastic rubbers on the basis copolymers of vinyl acetate and acrylates (Column 3, lines 55 - 60) as in claim 1. With regard to claim 2, the material for the

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core/the carrier layer has a glass transition temperature ( $T_g$ ) of below 0 °C is inherent since the materials of the carrier layer are the desired materials. As in claim 5, the pressure-sensitive adhesive tape comprises an adhesive based on a material selected from the group consisting of vinyl isobutyl ether and isobutene (Column 3, lines 62 – 65).

With regard to the limitations of “which have been cross-linked by a process selected from the group consisting of thermally and UV irradiation”, the limitation defines the product by how the product was made. Thus, claim 1 is a product-by-process claim. For purposes of examination, product-by-process claims are not limited to the manipulation of the recited steps, only the structure implied by the steps. See MPEP 2113. In the present case, the recited steps imply a structure of a flat carrier sheet. The reference suggests such a product.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over DE 100 63 018 A1 (machine translation) in view of Valdez (USPGPub 2004/0219356 A1).

DE '018 discloses a self-adhesive, flexible sealing tape (Claim 1) comprising at least one flexible, self-adhesive core or at least one flexible, self-adhesive carrier layer (Claim 7) provided with an envelope or two-sided coating comprising a second adhesive system (Claim 7), wherein the envelope/coating of comprises an expanded pressure-sensitive adhesive tape (Claims 5 and 8), and that the material for the core/the carrier layer is selected from the group comprising thermoplastic rubbers on the basis of styrene-isoprene-styrene block copolymers, styrene-butadiene-styrene block copolymers, copolymers of vinyl acetate and acrylates (Page 2, lines 3 – 24). However, DE '018 fails to disclose the envelope/coating has a foam-like structure, the sealing tape is equipped with reinforcing elements which stabilize the sealing tape in the longitudinal direction and the reinforcing element is selected from the group consisting of threads, nonwovens or interlaid scrims, wovens, knitted fabrics and crocheted fabrics.

Valdez teaches disclose an adhesive tape (Abstract) the envelope/coating has a foam-like structure (Page 4, Paragraph 0045), the sealing tape is equipped with reinforcing elements which stabilize the sealing tape in the longitudinal direction (Page 4, Paragraph 0049) and the reinforcing element is selected from the group consisting of threads, nonwovens and wovens (Page 4, Paragraph 0049) for the purpose of forming a tape that can withstand humidity and extreme temperatures without suffering from disintegration (Page 1, Paragraph 0014).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the foam tape with the stabilizing structure in DE '018 in



order to form a tape that can withstand humidity and extreme temperatures without suffering from disintegration as taught by Valdez.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Thurs. from 10:00-7:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena L. Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Primary Examiner  
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